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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
00/0027117	03/08/97	JONES	M

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SUITE 1500

ART UNIT

PAPER NUMBER

09/02/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/852,119

Applicant(s)
Jones

Examiner
Jacques H. Louis-Jacques

Group Art Unit
3614



☒ Responsive to communication(s) filed on May 6, 1997, March 17, 1998 and May 15, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-21 and 23-49 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21 and 23-49 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 6, & 7

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This office action is responsive to application filed May 06, 1997 followed by preliminary amendment filed on 17, 1998.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. See attached substitute PTO form 948.

Drawings

3. The preliminary amendments filed on March 17, 1998 and May 15, 1998 have been entered and considered by the examiner. Accordingly, claims 1-21 and 23-49 are presented for examination.

The substitute specification has also been entered and considered by the examiner.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 61, 67, 72, 76 and 79 of U.S. Patent No. 5,668,543. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been manifestly obvious to one of ordinary skill in the art at the time of the invention to forego or delete the "report generator...", although such is disclosed, if such report is not needed.

6. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 12 of U.S. Patent No. 5,657,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been manifestly obvious to one of ordinary skill in the art at the time of the invention to forego or delete the "vehicle progress report...", although such is disclosed, if such report is not needed.

7. Claim 15-21 and 23-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,623,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention

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combine the definition of the notification parameters in the notification system as it would adjust the schedule accordingly

8. Claims 1-21 and 23-49 are rejected under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9. Claims 1-21 and 23-49 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

10. Claims 1-21 and 23-49 are rejected under the judicially created doctrine of double patenting over claims 1-24 of U. S. Patent No. 5,400,020 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "an advance notification system and method"

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

12. Claims 1-14, 27-28, 31-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,648,770].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As disclosed in column 2, an analyzer evaluates the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible

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message to notify the party. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication.

13. Claims 1-14, 27-28, 31-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,444,444].

Ross '444 discloses an apparatus and method of notifying a recipient of an unscheduled delivery. The vehicle is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As described in column 2, a time interval (timing information) and distance (distance information) are computed. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication. Also, a message or notification is forwarded to user via a telephone associated therewith. See column 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing n audible message to notify the party.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 36, 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross [5,648,770], in the alternative Ross [5,444,444].

While neither Ross '770 nor Ross '444 specifically teaches the communication over the Internet, it would have been obvious to one skilled in the art at the time of the invention to be motivated to incorporate the use of the Internet into the Ross apparatuses and methods because such modification will enable to communicate with a various numbers of parties all over the world.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a.	3,845,289	French	Oct. 1974
b.	3,934,125	Macano	Jan. 1976
c.	5,122,959	Nathanson et al	Jun. 1992
d.	5,168,451	Bolger	Dec. 1992
e.	5,394,332	Kuwahara et al	Feb. 1995

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jacques H. Louis-Jacques** whose telephone number is (703) 305-9757.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Group Receptionist** whose telephone number is (703) 308-1113.

18. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 305-7687, (for formal communications intended for entry, please indicate as so; and for informal or draft communications, please label "PROPOSED" or "DRAFT")

/jlj

August 27, 1998

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER